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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/977,463 | 10/15/2001 | William C. Johnson JR. | GEO-55 | 3692 |

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| EXAMINER |
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MOHANDESI, JILA M

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| ART UNIT | PAPER NUMBER |
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3728

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02/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/977,463 | JOHNSON, WILLIAM C. | |
| | Examiner | Art Unit | |
| | Jila M. Mohandesi | 3728 | |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE 12/28/2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-11 and 13-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/28/2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-11 and 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claims, the limitation "a surface of the constant thickness of the insulating material is secured to the inner surface of the stretchable layer" is vague, indefinite and inaccurate. If the insulating material is secured to the inner surface of the stretchable leather layer, it will inherently get compressed by the stretching of the outer layer over it since it is no longer protected and enclosed by the toe box and will contradict the claim limitations which requires the insulating material to be in an uncompressed state.

In claim 14, the limitation "the layer of cold insulating material being secured to the lower underside of the toe box and the outer layer of stretchable leather" is vague,

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indefinite and inaccurate. The cold insulating material is inside the toe box and within the boot and therefore, can not be secured to the outer layer of the stretchable leather if it is inside the boot.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action..

5. Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (US patent no. 3,805,419). White '419 discloses all the limitations substantially as claimed including the following: a boot (see Figure1 and column 5, lines 32-35); an outer layer; an oversized toe box (1, see column 5, lines 23-31) supported on the outsole (see Figure 1, shows the toe box resting on the outsole) and covered by the outer layer; the toe box being sized to enclose a substantial thickness of compressible cold insulation material (foam layer 5 and the amount of dead air space in the foam layer 5, see column 5, lines 36-43) and the corresponding portion of the user's foot without compression of the cold insulating material when the boot is worn (because the insulating layer 5 is within toe box 1 and not in direct contact with the outer layer, it will not be compressed by the stretching of the outer layer over the toe area since it is enclosed in the toe box to allow for flexibility of the foot and prevent rubbing of the toe cap against the top of the user's foot); a layer of compressible cold insulating material in its uncompressed state (a layer of compressible cold insulating material 5 secured to the inside of the toe box in an uncompressed state), the cold insulating material having a constant thickness in the toe box (see Figures 6) and a surface secured to the lower

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of the underside of the toe box; a lining (6), see column 5, lines 44-51) having a first side facing the opposing surface of a portion of a user's foot (lowermost side of the insulating material); the lining extending below the opposing surface of the cold insulating material (lining attached to the sole (by means of the toe box) and not compressing the insulating layer to the protector); an outsole. White '419 discloses that the footwear can be any type of footwear such as injected PVC footwear, rubber footwear or any conventionally made footwear. Official notice is taken that is well known in the art that conventional made footwear are made from leather (leather being in and of itself is stretchable). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the toe box of White '419 in a conventionally boot made from leather and have the outer layer by stretchable leather.

6. Claims 10 and 14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Techboot WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419). WO'372 discloses all the limitations substantially as claimed including the following: a boot (see Figure 2); an outer layer 35 of stretchable leather (leather in and of itself is stretchable); an oversized toe box 27 supported on the outsole (see Figures 1-4, shows the toe box resting on the outsole) and covered by the layer of stretchable leather 35; the toe box being sized to enclose a substantial thickness of compressible cold insulation material (foam layer 43 and the amount of dead air space in the foam layer 43) and the corresponding portion of the user's foot without compression of the cold insulating material when the boot is worn (see page 5, lines 1-10, the toe cap is spaced "relatively high of the foot at the rear " to allow for flexibility of the foot and

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prevent rubbing of the toe cap against the top of the user's foot); a layer of compressible cold insulating material in its uncompressed state (a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state); a lining 34 having a first side facing the opposing surface of a portion of a user's foot (lowermost side of the insulating material); the lining extending below the opposing surface of the cold insulating material (lining attached to the sole and not compressing the insulating layer to the protector); an outsole 10. WO '372 does not disclose the insulating material having a constant thickness and being located but not being compressed between the toe box and a lining of the cold insulating material having a surface secured to the underside of the toe box. White '419 teaches that an insulating layer 5 having a constant thickness for a toe protected boot can be located, uncompressed, between the toe box 1 and the lining 6 to provide air absorption and cushioning to the user's foot during use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to place an insulating layer with constant thickness between the toe box and the liner of WO '372, as taught by White '419, to aid in protecting and cushioning the user's foot while insulating the boot as well. White '419 further discloses a toe cap 1 with a layer of cushioning material 5 attached to the under side of the toe cap by an adhesive 3 attaching the under side of the toe cap surface of the cushioning material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to attach the cushioning material to the toe cap by adhesive, as taught by White '419, to prevent the cushioning material from moving during flexing of the shoe during use.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419) as applied to claim 10 above, and further in view of Hill (US patent no. 2,814,888). The references as applied to claim 10 disclose all the limitations of the claims except for the thinner layer of cold insulating material extending below the second side of the lining. Hill '888 teaches that a pad 16 can be located under the lining and above another lining layer to add to cushioning of the toecap with respect to the user's toes. The pad would be another lining layer that would retard cold air from getting to the user's foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to add as many layers on insulating material under the toe cap, of the references as applied to claim 10 above as taught by Hill '888, to give the desired comfort of the user.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419) and Hill (US patent no. 2,814,888) as applied to claims 10 and 11 above, and further in view of Aumann (US patent no. 5,689,903). The references as applied to claims 10 and 11 disclose all the limitations of the claims except for a layer of water-impermeable, water-vapor permeable membrane extending below the layer of cold insulating material. Aumann '903 teaches that it is desirable to have a layer of water-impermeable, water-vapor permeable, waterproof material L (see col. 2, lines 32-37) located adjacent the user's foot in the toe area of the shoe to allow water vapor from the perspiration of the user's foot to escape without allowing water (i.e. waterproofing) to enter the shoe through the material. Therefore, it would have been obvious to one of ordinary skill in the art at the

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time the invention was made, to place a water-impermeable, water-vapor permeable material next to the user's foot for the boot of the references as applied to claims 10 and 11 above, as taught by Aumann '903 to allow for the user's foot to breath without building up perspiration.

Response to Arguments

9. Applicant's arguments with respect to claims 10-11 and 13-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jila M Mohandesi/
Primary Examiner
Art Unit 3728

JMM
March 07, 2008